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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/676,670	09/30/2003	William Brent Baker	21953	8206

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EXAMINER
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SAFAVI, MICHAEL

ART UNIT	PAPER NUMBER
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3673

DATE MAILED: 01/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/676,670

Applicant(s)

BAKER ET AL.

Examiner

M. Safavi

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5,7-21,23-27,30,31 and 34-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-5,7-21 and 23-26 is/are allowed.
- 6) ☒ Claim(s) 27,30,31 and 34-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 31, 2005 has been entered.

### ***Specification***

The amendment filed October 31, 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Language added within the paragraph beginning at line 7 of page 15 of the specification. Particularly, the added recitation of "[t]he reinforcing structure can be formed from a variety of materials suitable to increase the load-bearing capacity of the support gasket, including for example, materials which are stronger and/or stiffer than the support gasket. Examples of suitable materials from which the reinforcing structure can be formed include metallic materials such as steel. In general, as represented in FIG. 5C, the reinforcing structure can be formed from a material that is different than a material of which the support gasket is formed."

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 27, 30, 31, and 34-36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification had not originally set forth the "reinforcing structure" as "formed of a different material than the lower support gasket" as now appears in each of claims 27 and 31. Nor had the specification originally set forth the "reinforcing structure" as "formed of a metallic material." As now appears in each of claims 30 and 34. The original disclosure has support only for a reinforcing structure that includes "a pair of substantially rectangularly-shaped steel tubes". Applicants' disclosure cannot present at a later point in prosecution a generic, or broader, description of the "reinforcing structure". To do so would permit the claim to encompass embodiments to which Applicant did not originally have possession, *Chiron Corp. v Genentech Inc.*, 70 USPQ2d 1321 (CAFC 2004); *Studiengesellschaft Kohle m.b.H. v Shell Oil Co.* 42 USPQ2d 1674 (CAFC 1997).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 27 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by McCall.** McCall discloses, Figs. 2 and 4, a mold for forming a plurality of concrete panels in a vertical arrangement with the mold having a pair of opposing side wall forms 12/13 and a pair of opposing end wall form 23,24 and an elongate lower support gasket 10, (of reinforced, compliant polymer), defining a bottom surface of the mold cavity and having side walls configured to abut at least a portion of the side wall forms. Terminal end portions of the gasket 10 provide contact with the end wall forms as can be seen in Figs. 1 and 2. Securing structure in the form of tensioning member is at 36, for example. Lower support platform is at 6/7. Support frame is at 29. Retaining structure “associated” with each side wall form, and retaining the end wall forms, is any portion or element of the mold. (All parts of the mold are associated with one another). The

“inverse decorative pattern” is the inner face of the side wall form. The reinforcing structure of gasket 10 is “formed of a different material than the lower support gasket”, col. 2, lines 59-64.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 27, 30, 31, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCall in view of Chiovitti et al '326.**

McCall does not appear to specifically disclose metal reinforcement within the gasket 10 nor does McCall appear to specifically disclose a gasket formed of a polymer material. However, Chiovitti et al. discloses as old and well known formation of belting material for tires which belting material is formed of a polymer material reinforced with metal, (such as steel), col. 1, lines 40-48. Therefore, to have formed the belting gasket 10 of McCall from a polymer material having a metal reinforcing, (including steel reinforcing), thus providing a sturdier form component, would have been obvious to one having ordinary skill in the art at the time the invention was made as taught by Chiovitti et al.

**Claims 27, 35, 31, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCall in view of Gergele et al '488.**

McCall does not appear to specifically disclose tubular reinforcement within the gasket 10. However, Gergele et al. discloses as old and well known formation of belting material for tires which belting material is formed of a rubber material reinforced with metal tubes or metal cables, (such as steel tubes and cables), col. 6, lines 36-38 and 53-56. Therefore, to have formed the belting gasket 10 of McCall from a rubber material reinforced with metal tubes or metal cables, (such as steel tubes and cables), thus providing a sturdier form component, would have been obvious to one having ordinary skill in the art at the time the invention was made as taught by Gergele et al.

Claims 1-5, 7-21, and 23-26 are allowed.

### ***Response to Arguments***

Applicant's arguments filed October 31, 2005 have been fully considered but they are not persuasive. With regard to Applicants' remarks concerning the specification, as per 35 U.S.C. § 132 and 37 CFR § 1.121(f), no amendment may introduce new matter into the disclosure of an application. Applicants' arguments on page 12 of the response are not convincing. Applicant may now state that what is recited as "a pair of substantially rectangularly-shaped steel tubes" is only an example however, the originally filed disclosure does not set forth anything but a steel tube. Applicant appears to emphasize "different cross-hatching" in arguing for support of "different material".

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However, Fig. 5 appears as a sketch which cannot necessarily be taken to completely define the invention. One would look to the description within the specification to find from what material the elements 51 are formed. In fact, elements 51 are not illustrated with any cross-hatching to specifically, (or generally), indicate a polymer or a metal or any specific metal or polymer. In any event, the instant disclosure recites "a pair of substantially rectangularly-shaped steel tubes." The drawings taken with the specification show just that, "a pair of substantially rectangularly-shaped steel tubes." Applicants' remark that "if the reinforcing structure were the same material as the support gasket then the reinforcing structure would not operate to increase the load-bearing capacity of the support gasket" is pure conjecture. As stated above, Applicants' disclosure cannot present at a later point in prosecution a generic, or broader, description of the "reinforcing structure". To do so would permit the claim to encompass embodiments to which Applicant did not originally have possession, *Chiron Corp. v Genentech Inc.*, 70 USPQ2d 1321 (CAFC 2004); *Studiengesellschaft Kohle m.b.H. v Shell Oil Co.* 42 USPQ2d 1674 (CAFC 1997).

As to Applicant's arguments against McCall, McCall indeed, discloses a gasket 10 having a reinforcing formed of a different material than the gasket. The textile or cords are of a different material than the rubber forming the gasket to make the McCall "belting" disclosed at line 60 in col. 2 of McCall.



Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Safavi whose telephone number is (571) 272-7046. The examiner can normally be reached on Mon.-Thur., 8:30-5:00.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**MICHAEL SAFAVI**  
**PRIMARY EXAMINER**  
**ART UNIT 3673**

M. Safavi  
January 10, 2006